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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,657	11/07/2001	George Morrison	ARTM 1011-4 US	9884
34263	7590	11/26/2004		
O'MELVENY & MEYERS 114 PACIFICA, SUITE 100 IRVINE, CA 92618				
EXAMINER ROLLINS, ROSILAND STACIE				
ART UNIT		PAPER NUMBER		
3739				

DATE MAILED: 11/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,657

Applicant(s)

MORRISON ET AL.

Examiner

Rosiland S Rollins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 47-51, 62 are rejected under 35 U.S.C. 102(e) as being anticipated by Eggers et al. (US 6514248).**

Eggers et al. disclose a method for creating a tissue section within surrounding tissue comprising positioning a distal end of a catheter assembly at a target location within a patient, moving an elongate tissue separator element wherein the separator element cuts tissue as it is extended outwardly and rotating the separator element about an axis to separate a tissue section from surrounding tissue.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggers et al. '248 further in view of Burbank et al. (US 6540693).

Eggers et al. teach all of the limitations of the claims except moving a tissue holding element located at the distal end of the catheter assembly from a retracted condition to an extended tissue engaging condition. Burbank et al. disclose a similar procedure and teach that it is old and well known in the art to moving a tissue holding element located at the distal end of the catheter assembly from a retracted condition to an extended tissue engaging condition as illustrated in figure 15, to secure the device to the tissue. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide and move a tissue holding element located at the distal end of the catheter assembly from a retracted condition to an extended tissue engaging condition during the Eggers et al. procedure as taught by Burbank et al. to secure the device to the tissue.

Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eggers et al. '248 further in view of Wilk et al. (US 5417697).

Eggers et al. teach all of the limitations of the claims except surrounding the separated tissue section with a tubular braided element. Wilk et al. disclose a similar procedure and teach that it is old and well known in the art to surround the separated tissue section with a tubular braided element (see figures 8a-c and col. 8 lines 49+) to capture and remove tissue following separation. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to surround the

separated tissue section with a tubular braided element during the Eggers et al. procedure as taught by Wilk et al. to capture and remove tissue following separation.

Claims 56-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggers et al. '248 further in view of Burbank et al. '693 and Wilk et al. '697.

Eggers et al. teach all of the limitations of the claims except moving a tissue holding element located at the distal end of the catheter assembly from a retracted condition to an extended tissue engaging condition and surrounding the separated tissue section with a tubular braided element.

Burbank et al. disclose a similar procedure and teach that it is old and well known in the art to moving a tissue holding element located at the distal end of the catheter assembly from a retracted condition to an extended tissue engaging condition as illustrated in figure 15, to secure the device to the tissue. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide and move a tissue holding element located at the distal end of the catheter assembly from a retracted condition to an extended tissue engaging condition during the Eggers et al. procedure as taught by Burbank et al. to secure the device to the tissue.

Wilk et al. disclose a similar procedure and teach that it is old and well known in the art to surround the separated tissue section with a tubular braided element (see figures 8a-c and col. 8 lines 49+) to capture and remove tissue following separation. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to surround the separated tissue section with a tubular braided

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element during the Eggers et al. procedure as taught by Wilk et al. to capture and remove tissue following separation.

Response to Arguments

Applicant's arguments filed 10/12/04 have been fully considered but they are not persuasive. Applicant argues that Eggers et al. does not rotate the separator element about the axis before radially retracting the tissue separator element. In figures 3a & b, Eggers illustrates the separator element being rotated about the axis and in those figures the tissue has been substantially separated from surround tissue.

Applicant's arguments, with respect to the rejection(s) of claim(s) 55 and 56 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Wilk et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosiland S Rollins whose telephone number is 703/3082711. The examiner can normally be reached on Mon.-Fri. 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 703/3080994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Rosiland S Rollins
Primary Examiner
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